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RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2134

03560.002806

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: D. Jung
Hatsuo MACHIDA, et al.)	
	:	Group Art Unit: 2134
Appln. No.: 09/865,451)	
	:	
Filed: May 29, 2001)	
	:	
For: SIGNATURE AUTHENTICATING)	August 4, 2005
APPARATUS, SIGNATURE	:	
AUTHENTICATING PROGRAM,)	
AND STORAGE MEDIUM	:	
STORING SIGNATURE)	
AUTHENTICATING PROGRAM	:	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION
AND
REQUEST FOR WAIVER TO PERMIT SHIFT OF INVENTION

Sir:

In response to the final Office Action dated June 3, 2005, Applicants respectfully request reconsideration of this application in view of the following comments.

Restriction Requirement

The final Office Action makes a restriction requirement between the currently pending claims and the claims as originally filed, asserts that the originally presented invention has been constructively elected, and withdraws all pending claims from consideration as being directed to a non-elected invention. Applicants respectfully traverse the restriction requirement.

The Office Action asserts that the newly-submitted claims are directed to an invention that is independent or distinct from the invention originally claimed because the newly presented claims are directed to handwritten signatures, now requiring a search and classification into class 706.

Applicants respectfully point out that no additional claims were presented in the previous Amendment, but instead the independent claims were simply amended to recite “handwritten signature authenticating” instead of merely --signature authenticating--. Applicants submit that adding the term “handwritten” to the claims does not convert them into a different invention. Since “signature authenticating” as originally recited in the claims is inclusive of “handwritten signature authenticating,” any search now required should have been encompassed by the original search. Moreover, the very first sentence of the specification indicates that the disclosed system pertains to handwritten signatures, and that area should have been searched. M.P.E.P. §§ 704.01 and 904.03 specifically state that a prior art search is conducted after reading the specification and that references should be compared with the applicant’s disclosure. The fact the Examiner previously handling this

case did not search all relevant areas is not a valid basis for making a restriction requirement.

To the contrary, a restriction requirement is only proper when two criteria are met: 1) the inventions are independent or distinct as claimed, and 2) there is a serious burden on the examiner. M.P.E.P. §803. Thus, “[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as *claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction.” M.P.E.P. §808. The fact that an additional area must now be searched might satisfy the latter requirement (see M.P.E.P. §808.02); however, the Examiner has provided no basis for asserting that the currently pending claims and previously pending claims define distinct inventions. Applicants respectfully submit that adding the term “handwritten” to the claims does not render them patentably distinct.

Accordingly, Applicants submit that the restriction requirement is improper, and respectfully request withdrawal of that requirement.

Request for Waiver

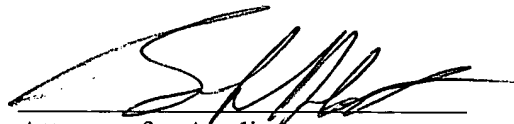
If the Examiner maintains the restriction requirement, Applicants are undecided as to whether to petition for withdrawal of the requirement or to file a further application for prosecution of the withdrawn claims. Ordinarily, a shift between inventions is not permitted as a matter of right upon the filing of a Request for Continued Examiner (RCE), and instead Applicants would be required to file a divisional application under 37 CFR §1.53(b), which is more burdensome and costly for Applicants. However, the PTO is

authorized to waive the prohibition against shifting inventions. See M.P.E.P. §819.01. Accordingly, if the Examiner chooses to maintain the restriction requirement, Applicants respectfully request an indication that he will grant such a waiver and permit Applicants to obtain further examination of the withdrawn claims by filing an RCE rather than a Rule 1.53(b) divisional application.

In view of the foregoing, Applicants request withdrawal of the restriction requirement, examination of the withdrawn claims, and an early Notice of Allowance.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. L. Klock', is written over a horizontal line.

Attorney for Applicants
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